

c.) Remarks

Claim 1, 2, 5 and 6 have been amended in order to recite the present invention with the specificity required by statute. The subject matter of the amendment may be found in the specification as filed, *inter alia*, at page 26, lines 3-16. Accordingly, no new matter has been added.

The Examiner has requested that Applicants affirm their provisional election to prosecute the invention of Group I (Claim 1), drawn to a protein according to SEQ ID NO:1. By the above amendment to claims 1 and 2, such election is hereby affirmed. Rejoinder of claims 5 and 6 is respectfully requested upon allowance of their antecedent claims.

With regard to Applicants' claim for foreign priority, the Examiner states no certified copy of Japanese Application No. 9-144948 has been received (see item 12 of the Office Action Summary and page 4, third paragraph of the Office Action). In response, Applicants wish to point out that such certified copy was filed in PCT/JP98/02445.

The specification and title are been objected to for the reasons stated at pages 4-5 of the Office Action. In response, both the title and the specification have been amended in conformity with the Examiner's kind suggestions. (In that regard, although the MPEP requires block capitalization of trademarks, the trademark noted is not block capitalized as registered. Accordingly, it is now presented inaccurately. Applicants have, nonetheless, complied with the MPEP requirements.)

Claim 1 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In response, claims 1 and 2 have both been amended in conformity with the Examiner's kind suggestions.

Claim 1 is also objected to for reciting non-elected subject matter. In response, all non-elected subject matter has been deleted therefrom.

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by SEQ ID NO:425 of Edwards, *et al.* (US 2004/0110939). As to US 2004/0110939, this application was not filed in the USPTO until October 15, 2001, after the December 1, 1999 filing date of parent application 09/445,258. However, Applicants note Edwards is a continuation-in-part of U.S. application 09/663,600 filed September 15, 2000 ultimately claiming priority to an earliest U.S. provisional No. 60/066,677 filed November 13, 1997. In order to reduce the issues, therefore, Applicants are obtaining verified translations of Japanese PCT application JP 98/02445 and their Japanese priority application 9-144948 (filed June 3, 1997). Those verified translations will be filed as quickly as possible. However, if the Examiner should reach this case for action before they are made of record, he is respectfully requested to telephone the undersigned.

The final outstanding matter, therefore, is the rejection of claim 1 under 35 U.S.C. §101 and under 35 U.S.C. §112, first paragraph because the claimed invention is said not to be supported by either a specific asserted utility or a substantial, well-established utility.

This rejection is not well-understood in view of the foregoing rejection over Edwards, which clearly teaches that SEQ ID NO:425 cited by the Examiner is understood to be an alpha-2-HS glycoprotein precursor due to the combination of (i) conserved pfam cystatin domains 1 and 2, together with (ii) the conserved cysteins at positions 36, 93, 104, 117, 137, 151, 154, 216, 224, 237, 254 and 368, and (iii) the active site QxVxG. As is well-known, these fetuins promote growth in tissue culture (Puck, *et al.*, *PNAS USA*, Vol.

59 (1968) 192:99), enhance bone resorption (Coclasure et al., *J. Clin. Endocrinol. Metab.*, Vol. 66 (1988) 187:92) and stimulate adipogenesis (Cayatte et al., *J. Biol. Chem.*, Vol. 265 (1990) 5883-88).

Not only is Edwards' teaching in conformity with Applicants' discussion at page 27, et seq., but it is also consistent with Applicants' NCBI conserved domain search. Applicants have taught the activity of SEQ ID NO:1 is an  $\alpha$ -2-HS glycoprotein precursor and those of ordinary skill in this art, including Edwards et al., concur.

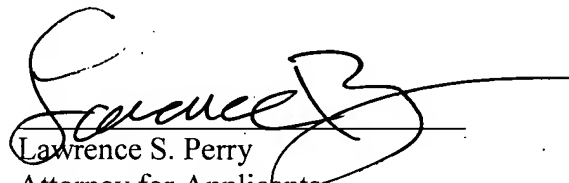
This is all the PTO's Training Manuals for Examination of Applications for Utility and Under 35 U.S.C. §112 require.

In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 1, 2, 5 and 6 remain presented for continued prosecution.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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